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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,160	03/30/2001	Matthew Bondy	33477US1	6295
116	7590	04/14/2004	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/822,160

Applicant(s)

BONDY, MATTHEW

Examiner

Matthew s Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3625

## **DETAILED ACTION**

### ***Drawings***

This application has been filed with informal drawings, which are acceptable for examination purposes only. Figure 1 through Figure 9 contains improper shading, which may affect clarity when reproduced.

Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

On page 6, reference numeral 14b, is used to describe both a shopping cart managing module and a shopping cart module, this proves confusing and inconsistent.

On page 9, reference numeral 51, is used to describe both an advertisement and an advertisement statement, this proves confusing and inconsistent.

On page 8, reference numeral 12, is used to describe an Internet service providing system. On page 9, reference numeral 12, is used to describe a system, this proves confusing and inconsistent.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 16-23 are rejected under 35 U.S.C. 101.**

Referring to claims 16-23. Claim 16 discloses a business system for promoting and selling the products and services of an e-tailer, the system comprising a group associated with a Web site, said group comprising a plurality of people. A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. Accordingly, it is suggested that any claim directed to a non-plant multicellular organism, which would include a human being within its scope, include the limitation "non-human" to avoid this ground of rejection. The use of a negative limitation to define the metes and bounds of the claimed subject matter is a permissible form of expression. In re Wakefield, 422 F. 2d 897, 164 USPQ 636 (CCPA 1970). Claims 17-23 are dependent upon claim 16.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 2-15 and 19 are rejected under 35 U.S.C. 112, second paragraph.**

Art Unit: 3625

Referring to claims 2-15. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is incomplete because the providing steps (a), (b), (c), (d) and (e) are not action steps and do not result in a method of promoting and selling the products and services of an e-tailer. Claims 3-15 are dependent upon claim 2.

Referring to claim 19. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 provides for the use of the Internet service system, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Bezos U.S. Patent No. 6,029,141.**

Referring to claim 1. Bezos discloses a method of selling items comprising the steps of:

- Providing an e-tailing system for displaying information relating to items available for purchase, and for receiving and processing orders to purchase such items (abstract: "Following, registration, the associate sets up a Web site to distribute hypertextual catalog documents that include marketing information about selected products of the merchant.");
- Providing a hyperlink from a web site to the e-tailing system (abstract: "In association with each such product, the catalog document includes a hypertextual 'referral link' that allows a user to link to the merchant's site and purchase the product.");
- At the e-tailing system, receiving a plurality of orders to purchase items, the plurality associated with the web site and using the hyperlink to access the e-tailing system from the web site (Figure 10a: "Best of all is that because of our association with Amazon Books we can get any book you want, at any time of day or night...");
- Processing the plurality of orders at the e-tailing system and identifying a corresponding plurality of items purchased (Figure 10c); and
- Shipping the plurality of items purchased to a geographical location associated with the plurality of purchasers (column 6, lines 12-20).

Art Unit: 3625

Referring to claim 2. Bezos discloses a method of promoting and selling the products and services of an e-tailing, the method comprising the steps of:

- Providing an electronic retailing architecture (Figure 1: **106**);
- Providing a Web site (Figure 1: **100**);
- Providing a group associated with said Web site, said group comprising a plurality of people (column 2, lines 19-39: In accordance with another aspect of the invention, the merchant site implements an automated associate enrollment process for allowing individuals and business entities to register as associates."");
- Providing a hyperlink between said Web site and said electronic retailing architecture for ordering goods (Figure 6);
- Geographical location for receiving said goods (column 16, lines 28-42).

Referring to claim 3. Bezos further discloses a method comprising steps of:

- Packaging said goods into a member package (column 6, lines 12-20 and column 16, lines 28-42);
- Packaging said member package into a group package (column 6, lines 12-20 and column 16, lines 28-42);
- Delivering said group package to said geographical location (column 6, lines 12-20 and column 16, lines 28-42).

Referring to claim 4. Bezos discloses a method wherein said group package is delivered in a predetermined interval or period (Figure 8, "This item usually ships within 24 hours.").

Art Unit: 3625

Referring to claim 5. Bezos further discloses a method comprising a step of providing an Internet service to said group (Figure 3a, Figure 3b, and Figure 3c).

Referring to claim 6. Bezos further discloses a method wherein said Internet service comprising assisting said group in establishing a Web site (Figure 3a, Figure 3b, and Figure 3c).

Referring to claim 7. Bezos further discloses a method comprising a step of preparing and maintaining a plurality of Web site frameworks, each of which serves as a basic architecture in creating said Web site (Figure 3a, Figure 3b, and Figure 3c).

Referring to claim 8. Bezos further discloses a method wherein said framework is designed to include said hyperlink (Figure 3b).

Referring to claim 9. Bezos further discloses a method wherein said Web site framework is configured to guide and help said group to create said Web site. (Figure 3a, Figure 3b, and Figure 3c).

Referring to claim 10. Bezos further discloses a method wherein said hyperlink is embedded in said Web site as an electronic store (Figure 6).

Referring to claim 11. Bezos further discloses a method wherein said electronic store includes an electronic store of said group (Figure 6).

Referring to claims 12 and 13. Bezos discloses a method according to claim 2 as indicated supra. Bezos further discloses a method wherein said group may be a business entity (column 2, lines 19-39: In accordance with another aspect of the invention, the merchant site implements an automated associate enrollment process for allowing individuals and business entities to register as associates.”). The term may be



Art Unit: 3625

is a conditional limitation within the context of the claimed invention because it merely recites what group could possibly be included, and not what group is included. Thus, the fact that the group may be an affinity group, wherein said affinity group may be a church, a school, or a health club is given little patentable weight.

Referring to claim 14. Bezos further discloses a method comprising a step of posting on said Web site an advertisement and information relating to said e-tailer (Figure 8)

Referring to claim 15. Bezos further discloses a method comprising a step of enrolling said group as a membership or partnership (abstract).

Referring to claims 16-23. Claims 16-21 are rejected under the same rationale as set forth supra.

### ***Conclusion***

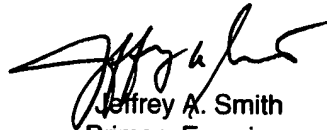
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
April 6, 2004



Jeffrey A. Smith  
Primary Examiner